UNITED STATES PATENT AND TRADEMARK OFFICE

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte SUSANN MARIE KEOHANE, GERALD FRANCIS
MCBREARTY, SHAWN PATRICK MULLEN, JESSICA MURILLO, and
JOHNNY MENG-HAN SHIEH

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Appeal 2009-014258
Application 10/777,646[1]
Technology Center 2400

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Before DENISE M. POTHIER, KALYAN K. DESHPANDE, and
MICHAEL R. ZECHER, *Administrative Patent Judges*.

ZECHER, *Administrative Patent Judge*.

DECISION ON APPEAL

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[1] Filed February 12, 2004. The real party in interest is International
Business Machines Corp. App. Br. 2.

I. STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134(a) (2002) from the Examiner's rejection of claims 1, 5, 6, and 10-12. Claims 2-4, 7-9, and 13-19 have been cancelled. App. Br. 4; Ans. 2-3. We have jurisdiction under 35 U.S.C. § 6(b) (2008).

We reverse and enter a new ground of rejection.

Appellants' Invention

Appellants invented a method, system, and computer program product for improving the filing of electronic messages within a message system. According to Appellants, the claimed invention filters the folders in a filing system in order to present a prospective user with a suggested selection of folders for filing a particular electronic message. Spec. ¶ [0001].

Illustrative Claim

1. A method for providing electronic message filing recommendations comprising:

detecting, at a sender system, a sender selection within a user interface of at least one suggested folder name for a composed electronic message for a recipient receiving the electronic message to select as a folder name for filing said electronic message;

attaching said at least one suggested folder name to said electronic message at said sender system for distribution to said recipient;

sending said electronic message with said suggested filing folder name from said sender system to a recipient system for said recipient;

responsive to receiving said electronic message at said recipient system for said recipient, filtering said electronic

message to detect said at least one suggested folder name specified by said sender in said electronic message for filing said electronic message from among a plurality of filing folders in a messaging filing directory; and

responsive to said recipient selecting to file said electronic message, automatically expanding a display directory of said plurality of filing folders to display said at least one suggested folder in a graphically distinguishable format from said display of other folders of said plurality of filing folders, such that a recommendation of relevant folders for filing said electronic message is provided.

Prior Art Relied Upon

Scian   US 2006/0026236 A1   Feb. 2, 2006
(PCT filed on Feb. 7, 2003, and claiming priority to Provisional application No. 60/430,369, filed Dec. 3, 2002)

Microsoft Corp., *Windows XP Automatically Expanding a display directory* 1-5 (2001)("Microsoft").

Michael Gleicher, *Integrating Constraints and Direct Manipulation* 171-174 (1992) (Thesis, Carnegie Mellon University)(on file with the School of Computer Science)("Gleicher").

Rejections on Appeal

Claims 1, 6, and 11 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Scian and Microsoft. Ans. 5-8.

Claims 5, 10, and 12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Scian, Microsoft, and Gleicher. *Id.* at 8-9.

Appellants' Contentions

Appellants contend that Scian's disclosure of identifying a pre-selected folder for storing a file attachment for an incoming message

does not teach or suggest the "detecting" method step recited in independent claim 1. App. Br. 15-16. Further, Appellants argue that Scian's disclosure of pre-selecting a folder by matching the hash of a message attribute from a received message with a hash of an entry within a folder does not teach or suggests a sender of a message selecting a suggested folder name for a recipient, such that when the recipient receives the message he or she may select the suggested folder name as a location to file the electronic message. App. Br. 16.

Examiner's Findings and Conclusions

The Examiner finds that Scian is directed to providing an improved method for pre-selecting a folder for a message. Ans. 11. In particular, the Examiner finds that Scian discloses using the attributes associated with the message to select a folder, such as the subject or sender of the message. *Id.* Therefore, the Examiner finds that Scian teaches or suggests the "detecting" method step recited in independent claim 1. Ans. 6 and 11.

II. ISSUE

The dispositive issue before us is whether the Examiner erred in finding that the combination of Scian and Microsoft teaches or suggests "detecting, at a sender system, a sender selection within a user interface of at least one suggested folder name for a composed electronic message for a recipient receiving the electronic message to select as a folder name for filing said electronic message," as recited in independent claim 1?

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III. FINDINGS OF FACT ("FF")

Appellants' Specification

FF 1. Appellants' Specification states that:

[t]he term "machine-readable medium" as used herein includes any medium that participates in providing instructions to processor **112** or other components of computer system **100** for execution. Such a medium may take many forms including, but not limited to, non-volatile media, volatile media, and *transmission media....Transmission media can also take the form of acoustic or light waves, such as those generated during radio frequency or infrared data communications.*

Spec. ¶ [0030](emphasis added).

Scian

FF 2. Scian discloses using the features of a message (24) to pre-select a folder. In particular, Scian's figure 5 illustrates that the message (24) includes message attributes (40) and a message body (42). Scian discloses that the message attributes (40) include specific attributes, such as a subject attribute (44), a sender attribute (46), and other attributes (i.e., time sent, encoding, and contents). ¶ [0021]; figure 5.

FF 3. Scian's figure 1 illustrates that the folder pre-selection cache (48), message comparison module (50), and folder pre-selection module of system (20) determines the folder (22 or 22') that is pre-selected for storing the message (24). ¶ [0022]. In particular, Scian discloses that the message comparison module (50) compares the current message (24) with entries (57) in either or both of the sender cache (54) or the subject cache (56) to determine an entry having a message attribute (40) that matches a message attribute in the current message (24). ¶ [0024]; *see also* figures 3, 5.

FF 4. If the current message is an incoming message, Scian discloses that the pre-selected folder (22 or 22') is for storing the attachment. That is, if the user indicates that he or she wishes to save the attachment, Scian discloses presenting the pre-selected folder (22 or 22') as an easily executable option. However, if the current message is an outgoing message, Scian discloses presenting the pre-selected folder (22 or 22') as the folder in which the user can find the file to be attached to the current message. ¶ [0045].

IV. ANALYSIS

Claim 1

We find error in the Examiner's obviousness rejection of independent claim 1. Independent claim 1 recites, *inter alia*, "detecting, at a sender system, a sender selection within a user interface of at least one suggested folder name for a composed electronic message for a recipient receiving the electronic message to select as a folder name for filing said electronic message."

At best, we find that Scian discloses pre-selecting a folder for a message by using a message comparison module to match the attributes of the message, such as subject and sender, to the attributes of previously sent messages already stored in folders located at the recipient's system. FFs 2 and 3. However, we find that Scian fails to teach or suggest that the sender, at his or her respective system, designates or selects a folder name for filing the message for a recipient receiving the message, as required by independent claim 1. Moreover, while Scian discloses pre-selecting a folder name for an attachment associated with an outgoing message (FF 4), this

portion of Scian's disclosure only pertains to pre-selecting a shared folder in which the recipient of the message can find the attachment. That is, prior to distributing the outgoing message, Scian does not teach or suggest that the sender of the message selects a folder name for the recipient, such that when the recipient receives the message the recipient may select to file the message in the folder suggested by the sender. Consequently, we find that the Examiner improperly relied upon Scian to teach or suggest the disputed claim limitation. Further, we find that Microsoft does not remedy the above-noted deficiencies in the Examiner's obviousness rejection.

Since Appellants have shown at least one error in the Examiner's obviousness rejection of independent claim 1, we need not reach the merits of Appellants' other arguments. It follows that the Examiner erred in concluding that the combination of Scian and Microsoft renders independent claim 1 unpatentable.

Claims 5, 6, and 10-12

Since independent claims 6 and 11 recite the same or a similar claim limitation as discussed *supra*, we find that the Examiner erred in rejecting these claims for the same reasons set forth in our discussion of independent claim 1.

Claims 5, 10, and 12

We find that Gleicher does not remedy the above-noted deficiencies in the Examiner's obviousness rejection. Therefore, since dependent claims 5, 10, and 12 incorporate by reference the same or a similar claim limitation as discussed *supra*, we find that the Examiner erred in rejecting these claims for the same reasons set forth in our discussion of independent claim 1.

V. NEW GROUND OF REJECTION

We enter the following new ground of rejection pursuant to our authority under 37 C.F.R. § 41.50(b).

35 U.S.C. § 101 Rejection

Claim 11

Independent claim 11 recites, *inter alia*, "[a] computer program product for providing electronic message filing recommendations comprising: a recording medium…" and various means "recorded on [the] recording medium."

Upon reviewing Appellants' Specification for context, a computer program product included on a recording medium may take the form of transmission media, such as acoustic or light waves generated during radio frequency or infrared data communications. FF 1. The remainder of the claim recites means-plus-function limitations or steps recorded on such medium. Consequently, we find that the claimed "computer program product…comprising: a recording medium…" can be broadly, but reasonably construed to encompass no more than a transitory, propagating signal. Further, since the claim is not limited to a non-transitory, tangible medium within one of the four statutory classes of 35 U.S.C. § 101,[2] we find that independent claim 11 is directed to non-statutory subject matter.

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[2] "A transitory, propagating signal . . . is not a 'process, machine, manufacture, or composition of matter' [under 35 U.S.C. § 101]" and, therefore, does not constitute patentable subject matter under § 101. *In re Nuijten*, 500 F.3d 1346, 1357 (Fed. Cir. 2007). Claims that are so broad that they read on nonstatutory as well as statutory subject matter are unpatentable. *Cf. In re Lintner*, 458 F.2d 1013, 1015 (CCPA 1972) (citation omitted) ("Claims which are broad enough to read on obvious subject matter
Footnote continued on next page.

Claim 12

For the same reasons set forth *supra*, we find that dependent claim 12 is also directed to non-statutory subject matter.

VI. CONCLUSIONS OF LAW

1.   The Examiner has erred in rejecting claim 1, 5, 6, and 10-12 as being unpatentable under 35 U.S.C. § 103(a).

2.   We enter a new ground of rejection against claims 11 and 12 as being directed to non-statutory subject matter under 35 U.S.C. §101.

VII. DECISION

1.   We reverse the Examiner's decision to reject claims 1, 5, 6, and 10-12 as being unpatentable under 35 U.S.C. § 103(a).

2.   We newly reject claims 11 and 12 as being directed to non-statutory subject matter under 35 U.S.C. §101.

37 C.F.R. § 41.50(b) provides that, "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review."

37 C.F.R. § 41.50(b) also provides that the Appellants, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise

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are unpatentable even though they also read on nonobvious subject matter."). "A claim drawn to such a computer readable medium that covers both transitory and non-transitory embodiments may be amended to narrow the claim to cover only statutory embodiments to avoid a rejection under 35 U.S.C. § 101 by adding the limitation 'non-transitory' to the claim." David J. Kappos, Subject Matter Eligibility of Computer Readable Media, 1351 OFF. GAZ. PAT. OFFICE 212 (Feb. 23, 2010).

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one of the following two options with respect to the new grounds of

rejection to avoid termination of proceedings (37 C.F.R. § 1.197 (b)) as to

the rejected claims:

> (1) *Reopen prosecution.* Submit an appropriate amendment of the
> claims so rejected or new evidence relating to the claims so rejected,
> or both, and have the matter reconsidered by the examiner, in which
> event the proceeding will be remanded to the examiner. . . .
> (2) *Request rehearing.* Request that the proceeding be reheard under
> 37 C.F.R. § 41.52 by the Board upon the same record. . . .

No time period for taking any subsequent action in connection with

this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

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REVERSED
37 C.F.R. § 41.50(b)

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